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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,856	06/20/2001	William G. Dennis	0670004	3188

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EXAMINER

HAYES, MICHAEL J

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,856

Applicant(s)

DENNIS ET AL.

Examiner

Michael J. Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-38 and 40-49 is/are pending in the application.
4a) Of the above claim(s) 40-42 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 32-38 and 43-49 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 20 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Newly submitted claims 40-42 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: these new claims are directed to a species different from the species acted upon in prosecution. Claims 40-42 are directed to a species having a stay at least a portion encapsulated in the seal. The claims 32-36, 38, and 39, acted upon during prosecution are drawn to an embodiment not including the stay. See Pub. No. US 2002/0010424, paragraph 0047 for description of the embodiment including the stay 50.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 40-42 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 32-36, 38, 43-47, and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by FLATLAND et al. (U. S. Patent No. 5,752,938). Flatland discloses an instrument seal assembly including an upper body portion defining a throughbore, a cylindrical wall protector integrally formed with the upper surface at the throughbore and extends substantially into an

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upper seal portion, a lower body portion defining a cannula receiving opening, a valve seal with upper 45 and lower 32 portions. The cylindrical wall protector is substantially tubular due to its annular shape and liner dimension. Flatland further discloses an inner support member, having a shoulder, extending into the interior portion (See support member of figs. 23, 29), a sloped transition wall between the upper and lower portions with a shoulder extending from the wall where the shoulders of the wall and support member mate (see bottom of forked section supporting seal 45), a seal between wall shoulder and support member shoulder, and a frusto-conical sealing member. See Figs. 23, 29.

Claims 32-37 and 43-48 are rejected under 35 U.S.C. 102(b) as being anticipated by SMITH et al. (U. S. Patent No. 5,603,702). Smith discloses an instrument seal assembly including an upper body portion defining a throughbore, a lower body portion defining a cannula receiving opening, a valve seal with upper and lower portions, and a cylindrical wall protector integrally formed with the upper surface at the throughbore and between the throughbore and the upper seal portion and extends substantially into an upper seal portion. The cylindrical wall protector is substantially tubular due to its annular shape and liner dimension. Smith further discloses an inner support member, having a shoulder, mating with the shoulder of a sloped transition wall and a seal between the two. See Figs. 13, 15.

Claims 32-35 and 43-46 are rejected under 35 U.S.C. 102(b) as being anticipated by HABER et al. (U. S. Patent No. 5,391,153). Haber discloses an instrument seal assembly including an upper body portion defining a throughbore, a cylindrical wall protector 100 integrally formed with the upper surface at the throughbore and extends substantially into an upper seal portion, a lower body portion defining a cannula receiving opening, a valve seal with

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upper and lower portions. The cylindrical wall protector is substantially tubular due to its annular shape and liner dimension. Haber further discloses an inner support member 104, with a shoulder extending into the interior, a lower body portion with a sloped transition wall that mates upper body to lower body 10 as seen in fig. 4.

Response to Arguments

Applicants argue that Flatland does not show a cylindrical wall member integrally formed with an upper surface at the throughbore. The examiner disagrees and refers Applicants to figs. 23 and 29 which show a cylindrical wall member (member located above and between upper valve seal wall portion 45 and the throughbore) projecting into the interior of the upper body portion. The member is cylindrical due to its annular shape with linear dimension. This extends into the interior and places the wall protector between the throughbore and the valve seal. The cylindrical wall member is integral with the upper surface portion of the assembly as seen in the figures. Applicants characterization of a wall 45 is misplaced. Element 45 is the upper seal portion, cylindrical wall protector is seen extending from the upper surface to the interior of the seal.

Applicants argue that Smith does not show a cylindrical wall protector integrally formed with the upper surface of a throughbore or the protector between the throughbore and upper seal wall, extending into the upper seal portion. The examiner disagrees and refers Applicant to figs. 13 and 15. Smith shows a throughbore which has an upper surface. Integral with this upper surface is a wall protector forming the passageway for the instrument 400 in the upper seal portion, located between the seal 110 and the throughbore. The upper seal portion is mounted in

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the upper body portion. The lower body portion (from the sloped transition wall and below) does not mount the upper seal portion.

Applicant argues that Haber does not have a cylindrical wall protector integrally formed with the upper surface of a throughbore and extending inwardly into an interior of the upper body portion. The examiner does not agree and refers Applicant to fig. 4 where the upper body portion is shown above the sloped transition wall connecting to the lower body portion 10. The cylindrical wall portion 100 extends into the interior of the upper body portion. This wall protector 100 is integral with the upper surface of the throughbore and extends into the interior (i.e., extends past the outermost boundary of the upper portion of the upper seal portion).

The prior art shows an opening at the bottom of the seal assembly to define a cannula receiving opening. Applicants argument that the prior art uses a trocar or does not show a cannula receiving opening is not convincing because the prior art discloses an opening in the lower body portion that is capable of receiving a cannula.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. VANDENBROEK et al. (U. S. Patent No. 5,709,664) shows a seal assembly with upper and lower body portions, wall protector, and a unitary seal with upper and lower portions.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Hayes at (571) 272-4959. The examiner can usually be reached Monday -Thursday, 7:00-4:30, and on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi, can be contacted at (571) 272-4977. The fax number for submitting official papers is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mjh
4 August 2005



MICHAEL J. HAYES
PRIMARY EXAMINER